

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALLAN COCKRAM

Appeal No. 96-3622
Application 29/019,382¹

ON BRIEF

Before KIMLIN, THOMAS and STAAB, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the examiner's final rejection of the only claim pending:

The ornamental design for a 'BINGO MARKER' as shown and described.

¹ Application for patent filed March 1, 1994.

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The examiner has relied upon the following reference:

Futino Des. 325,751 Apr. 28, 1992

The claim stands rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Futino alone.

We refer to the briefs and the answers for the respective positions of the appellant and the examiner.

OPINION

Initially, we note that the single claim at bar covers alternative embodiments of a single inventive concept. In re Rubinfeld, 270 F.2d 391, 396, 123 USPQ 210, 214 (CCPA 1959), cert. denied, 362 U.S. 903, 124 USPQ 535 (1960). The prosecution history reflects this. Therefore, the rejection under 35 U.S.C. § 103 is proper if the prior art demonstrates the obviousness of just one of appellant's alternative embodiments. Whether the prior art would have rendered obvious the other embodiment(s) is irrelevant. Ex parte Wolf, 152 USPQ 71, 72 (Bd. App. 1965).

We reverse the rejection of the design claim on appeal under 35 U.S.C. § 103 in light of the examiner's reliance upon Futino alone.

"In determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration." See In re Rosen, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982). Where the inquiry is to be made under 35 U.S.C. § 103, the proper standard is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. See In re Nalbandian, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). Furthermore, as a starting point when a § 103 rejection is based upon a combination of references, there must be a reference, a "something in existence," the design characteristics of which are basically the same as the claimed design. Once a reference meets the test of a basic design reference, ornamental features may reasonably be interchanged with or added from those in other pertinent references, when such references are "so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." See In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982); In re Glavas, 230 F.2d 447, 450, 109 USPQ 50, 52 (CCPA 1956); In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). If, however, the combined teachings of the applied references suggest only components of the claimed design,

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but not its overall appearance, an obviousness rejection is inappropriate. See In re Cho, 813 F.2d 378, 382, 1 USPQ2d 1662, 1663 (Fed. Cir. 1987).

Page 3 of the answer indicates the examiner's view that it would have been obvious to one of ordinary skill in the art at the time of the invention "to have varied the number of spheres, as applicant himself is claiming a multiple number of spheres." In the responsive arguments portion of the principal answer, the examiner indicates at the bottom of page 4 that "it is the examiner's contention that merely varying the number of spheres would have been an obvious variation, in view of appellant's own disclosure. As appellant has shown that adding and subtracting spheres are obvious variations, then the same holds true for the reference used in the rejection."

Besides being based on apparent prohibitive hindsight, the examiner's reasoning is misplaced because we do not see that the examiner has provided a so-called Rosen-type reference which, as we noted earlier, must present to the ordinary designer design characteristics which are "basically the same" as the claimed

design. Futino clearly shows only one sphere. The broadest or simplest embodiment of the claimed invention is depicted in Figures 17 through 24 which show two stacked spheres. Since the examiner has presented evidence in Futino of only part or one half of a thing in existence, the design characteristics which

are required to be basically the same, the examiner's position appears to also only present components of a claimed design.

In re Cho, supra, indicates that an obviousness rejection is not appropriate when only the components of a claimed design are present but not its overall appearance in the prior art relied upon.

The examiner's basic rationale that it would have been obvious to the ordinary designer to have varied the number of spheres is further misplaced. As discussed in In re Harvey, supra, the examiner's rationale appears to be utilizing design concepts. The examiner's basic rationale may have some place in utility patent application analyses, but not in designs. The examiner's evidentiary void cannot be filled by a conceptualized approach.

In order for us to sustain the examiner's rejection under

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35 U.S.C. § 103, we would need to resort to speculation or unfounded assumptions to supply deficiencies in the factual basis of the rejection. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000 (1968). This we decline to do.

In view of the foregoing, the decision of the examiner rejecting the design claim on appeal under 35 U.S.C. § 103 is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
JAMES D. THOMAS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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LAWRENCE J. STAAB)	
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